

REMARKS/ARGUMENTS

The office action of June 16, 2006 has been carefully reviewed and these remarks are responsive thereto. Reconsideration and allowance of the instant application are respectfully requested. Claims 1 and 2 have been amended. New claims 5-12 have been added by this amendment and are fully supported by the original written description and drawings. Claims 1-12 are pending in this application.

Preliminarily, Applicants would like to thank the Examiner for the courtesies extended to their representatives, during the interview of August 17, 2006. The following remarks include Applicants' substance of interview pursuant to MPEP § 713.04.

The specification stands objected to because of various informalities identified in the action. Applicants have amended the specification to cure these and other informalities discovered therein. Accordingly, withdrawal of the objection is respectfully requested.

Claims 1-4 stand rejected under 35 U.S.C. § 101 as being drawn to non-statutory subject matter. In view of the Examiner's helpful comment regarding an example of tangible subject matter on page 4 of the action, applicants have amended claim 1 to further recite, among other features, "displaying a thumbnail image for at least one annotated document in the obtained set of annotated documents." As agreed during the interview, claim 1 as amended defines statutory subject matter pursuant to section 101.

Claims 1-4 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. patent no. 6,389,435 to Golovchinsky et al. ("Golovchinsky").

Amended claim 1 recites, among other features, "searching for at least one of the attributes in the at least one searchable index to obtain a set of annotated documents that is a subset of the plurality of annotated documents." The cited portion of Golovchinsky discloses using "the selection of multiple original freeform digital ink marks as a query that causes the system to display a ranked list of search results, where each item in the list is a passage." (Column 4, lines 29-32) However, as discussed during the interview, Golovchinsky's discussion of a list of passages fails to teach or suggest obtaining a set of annotated documents. Also, the query in Golovchinsky appears to search the text of the original document. There is no mention of searching for at least one of the attributes of annotation data.

Amended claim 1 also recites, among other features, “displaying a thumbnail for at least one annotated document in the obtained set of annotated documents.” As explained above, Golovchinsky does not teach or suggest obtaining a set of annotated documents. Further, amended claim 1 recites, “receiving a plurality of annotated documents.” Golovchinsky only discusses the existence of more than one document when discussing copying “marks on an object to other objects which are related to the first object in some way” in columns 5 and 6. Thus, as discussed during the interview, Golovchinsky fails to teach or suggest receiving a plurality of *annotated* documents.

For at least these reasons, amended claim 1 is allowable over the applied reference. Dependent claims 2-4 are allowable for at least the same reasons as their ultimate base claim, and further in view of the novel features recited therein.

In addition, new claim 5, which depends from claim 1, recites “wherein the obtained set of annotated documents includes at least two documents and a thumbnail image is displayed for each annotated document in the obtained set of annotated documents.” Golovchinsky fails to teach or suggest displaying thumbnail images for more than one document.

New claims 7-12 are allowable over the art of record for at least reasons similar to those discussed above.

CONCLUSION

It is believed that no fee is required for this submission. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

All rejections having been addressed, applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same.

Respectfully submitted,
BANNER & WITCOFF, LTD.

Dated: August 18, 2006

By: /Gary D. Fedorochko/
Gary D. Fedorochko
Registration No. 35,509

1001 G Street, N.W.
Washington, D.C. 20001-4597
Tel: (202) 824-3000
Fax: (202) 824-3001